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REPLY BRIEF

Applicant : Jörneus, et al.
App. No : 10/583,817
Filed : December 8, 2008
For : IMPLANT
Examiner : Eide, Heide Marie
Art Unit : 3732
Conf # : 8735

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/Rabinder N. Narula/

Rabinder N. Narula, Reg. No. 53,371

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Sir:

In response to the Examiner's Answer dated December 19, 2011, Appellants submit this Reply Brief for consideration in U.S. Patent Application No. 10/583,817. Pursuant to page 13 of the Examiner's Answer, this Reply brief addresses the new ground of rejection and is in compliance with the remaining sections of 37 CFR 41.37(c) as explained in MPEP 1208.

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I. STATUS OF CLAIMS

Claims 1, 2, 5-9, and 13-22 are currently pending in the application, and these claims are the subject of this appeal. Claims 3-4 and 10-12 were canceled previously. Claims 1, 2, 5-9, and 13-22 were rejected in the Office Action dated February 8, 2011.

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II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. NEW GROUNDS FOR REJECTION: The rejection to Claims 17 and 21 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

B. The rejection of Claims 1-2, 6-9, 13-14 and 17-22 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,419,491 issued to Ricci, et al. (hereinafter “Ricci”) in view of U.S. Patent No. 6,364,663 issued to Dinkelacker (hereinafter “Dinkelacker”).

III. ARGUMENT

A. New Grounds for Rejection: The Specification Supports the “Greater Than 20%” Limitation

In the Examiner’s Reply Brief, a new ground for rejection is presented in which Claims 17 and 21 are rejected under 35 U.S.C. 112, first paragraph as failing comply with the written description requirement.

To simplify the issues for this pending Appeal, the Applicant has chosen not to contest the rejection of the newly presented rejection of dependent claims 17 and 21. However, as outlined below, Applicant does wish to maintain the present Appeal with respect to the rejection under Section 103(a) of Claim 1-2, 5-9, 13-14 and 15-22.

B. Claim 1-2, 5-9, 13-14 and 15-22 are Improperly Rejected Under Section 103(a)

Appellant respectfully disagrees with and traverses the Examiner’s comments in the Answer for the reasons set forth in Applicant’s previously filed Brief. With respect to the Examiner’s comments in paragraph 10 (pages 1112), Applicant presents the following additional comments.

As noted by the Federal Circuit, a “[d]etermination of obviousness cannot be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention.” *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998). In this case, Ricci discloses grooves on a collar portion 154 of the implant. However, Ricci fails to disclose that “at least a portion of the pattern of grooves and/or recesses [are] inclined with respect to a longitudinal axis of the implant” as recited in Claims 1 and 19. The Examiner points to Dinkelacker as disclosing this missing element and that it would be obvious to substitute the grooves of Ricci with the grooves of Dinkelacker. However, as explained below, one of ordinary skill in the art would not be motivated to make this substitution.

First, the Examiner incorrectly states that the “collar” 104 of Dinkelacker is for placement in the gum tissue. Instead, Figure 18 (reproduced below) shows that the collar is for placement against bone tissue 108 (“The collar 104 and a part of the body 105 up to the bottom third of the

first or top step 106 are in the area of the naturally compact bone 108 that is under the edge of the jawbone and neighbors the spongiosa 109 of the jawbone below.” Col. 6, lines 19-24).

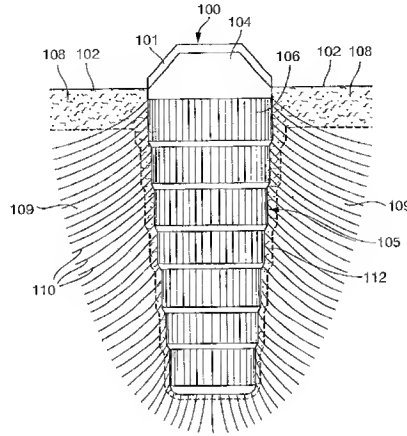


Fig. 18

As noted in MPEP 2141.02, “a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” In this case, Applicant submits it would not be obvious to one of skill in the art to take the teachings of Dinkelacker which discloses a groove pattern for the lower anchoring portions of the implant and no such groove pattern in the collar portion and then apply same groove pattern to the collar portion of the implant of Ricci. Such a combination goes against the teachings of Dinkelacker as a whole. Indeed, Dinkelacker only guidance to one of skill in the art with respect to the collar portion is that the collar should not include the claimed groove pattern on the collar. Even for the sake of argument if there is motivation to combine the references, instead of the combination proposed by the Examiner, at best, one of skill in the art in light of Dinkelacker would merely be motivated to add the specific groove pattern of Dinkelacker to the lower anchoring portions of the implant of Ricci and not to the collar.

In addition to the above argument, Ricci teaches away from “grooves and/or recesses [having] a depth (D) which lies in the range of about 50-100 μm and a width (B) in the range of about 100-150 μm ” as recited in Claims 1 and 19. Namely, Ricci consistently discloses that the ridges and grooves on the collar/lower region 152 has a width of 2-25 microns and a depth 2-25 microns. Ricci emphasizes these specific dimensions as being important several times. See e.g., Abstract; Independent Claims 1, 18 and 22; the Summary of the Invention at Col. 4, lines 43-44;

and the Detailed Description of the Invention at Col. 9, lines 7-9; Col. 9, lines 47-50; and Col. 10, lines 50-57.

Moreover, Ricci emphasizes at that grooves larger than a width of 2-25 microns and a depth 2-25 microns are not desirable.

Thereby, all prior art of record addresses the issue of bone adhesion to an implant at either a level of tissue ingrowth **entailing a dimension well above that set forth herein** or relates to control of the growth or orientation of individual cells, as opposed to cell colonies, which resultingly require employment of surface characteristics of dimensions substantially smaller than that employed by the within inventors. Col. 4, lines 27-34 (emphasis added).

Dinkelacker, in turn, discloses grooves in the body area (i.e., not the collar) between 20-300 μ wide and 10-150 μ m deep. Thus, as a whole, at best Dinkelacker discloses a particular groove depth and width for the body portion of the implant not the collar portion. Thus, there is no motivation going against the express teachings of Ricci by enlarging the groove dimensions of Ricci.

C. Conclusion

As discussed above, the rejection under Section 103(a) is improper because the combination of Ricci and Dinkelacker is improper and is the result of impermissible hindsight reasoning. The Final Office Action fails to provide any reason why a person of skill would otherwise modify the combination to produce the dental implant recited in Claims 1 and 19. Accordingly, Appellants respectfully ask this Board to reverse the rejections of Claims 1-2, 5-9, 13-14 and 15-22, as well as under Section 103(a).

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Dated: 2-16-2012

By: /Rabinder N. Narula/

Rabinder N. Narula

Registration No. 53,371

Attorney of Record

Customer No. 20995

(949) 760-0404

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